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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,070	03/19/2004	Masakazu Sueda	D-1607	7044

7590 04/19/2005

HAUPTMAN KANESAKA BERNER PATENT AGENTS, LLP  
Suite 310  
1700 Diagonal Road  
Alexandria, VA 22314

EXAMINER

PATEL, VISHAL A

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/804,070

Applicant(s)

SUEDA, MASAKAZU

Examiner

Vishal Patel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 13 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholson (US. 4,387,904).

Regarding claim 1: Nicholson discloses a metal gasket having a hole (hole in gasket) to be sealed. The metal gasket comprising a first metal base plate having a first main bead around the hole (top bead formed on a top plate that forms the gap g), a first outer sub-bead section (plurality of beads after the first main bead) smaller than the first main bead and provided outside the first main bead, a second metal base plate laminated with the first metal plate and having a second main bead (bottom bead formed on a bottom plate that forms the gap g) around the hole, a second outer sub-bead section (bottom plurality of beads after the second main bead) smaller than the second main bead and provided outside of the second main bead and the second outer sub-bead section abutting against the first outer sub-bead section for sealing (the first and second sub-bead sections abut each other).

Regarding claim 2: The first and second main beads are arranged to project outwardly from the gasket (this is the case since they form the gap g).

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Regarding claim 3: The first and second main beads are half beads (the first and second main beads are half beads) formed around the hole.

Regarding claims 4-6: The first and second outer sub-bead sections abut against each other at side peripheries thereof (this is the case since the first outer sub-bead section is received in the second outer sub-bead section). The first and second outer sub-bead sections orient in same direction so that one of the first and second outer sub-bead sections fit in the other of the first and second outer sub-bead sections (figure 3). At least one of the first and second outer sub-bead sections is formed intermittently in a circumferential direction.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Diez et al (US. 6,769,696).

Regarding claim 1: Diez (figure 15) discloses a metal gasket having a hole (14) to be sealed. The metal gasket comprising a first metal base plate having a first main bead around the hole (110a), a first outer sub-bead section (116) smaller than the first main bead and provided outside the first main bead, a second metal base plate laminated with the first metal plate and having a second main bead (112a) around the hole, a second outer sub-bead section (114) smaller than the second main bead and provided outside of the second main bead and the second outer sub-bead section abutting against the first outer sub-bead section for sealing (the first and second sub-bead sections abut each other). The side peripheries of the sub-beads are abutting.

Regarding claim 2: The first and second main beads are arranged to project outwardly from the gasket (see figure 15).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diez et al.

Diez discloses the invention substantially as claimed above (figure 15) but fails to disclose the first metal plate further includes a first inner sub-bead section smaller than the first main bead and provided inside the first main bead, the second metal base plate further includes a second inner sub-bead section smaller than the second main bead and provided inside the second main bead and the second inner sub-bead section abutting against the first inner sub-bead section for sealing. As showed in figure 8 that structure 46' (plurality of beads) can be placed on both side of a bead (44'). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the invention of figure 15 to have the same structure on other side of beads (110a and 112a) as taught by Diez, to provide reduce high deformations of main sealing beads (column 11, lines 40-55 of Diez).

***Allowable Subject Matter***

6. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue, Kitamura, Jinno et al, Yamada et al, Miura et al, Udagawa, Takada et al and Takahashi et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is (571) 272-7060. The examiner can normally be reached on Monday through Friday from 7:30 PM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (571) 272-7049.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** 703-872-9326, for formal communications for entry before Final action: or,  
703-872-9327, for formal communications for entry after Final action.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).

VP  
April 11, 2005

A handwritten signature in black ink, appearing to read 'Vishal Patel', with a stylized flourish at the end.

Vishal Patel  
Patent Examiner  
Tech. Center 3600